REMARKS

Claims 89 and 130-187 are pending. Claims 142 and 159 are canceled. Claims 143, 148 and 152-154 have been amended to depend from claim 89 or 141. Claims 188-194 are new. Support for these claims is found, for example, in claims 89, 178, 179 and 181, Formula XVII on page 40, page 53, line 11, and in the subembodiments found on page 44 of the specification. Claims 188-194 are also supported by the third preferred embodiment on pages 24-25 of U.S. Provisional Application No. 60/206,585, to which this application claims priority, and which is incorporated by reference on page 12 of the specification. No new matter is added by these amendments.

Claims 89 and 130-187 stand rejected. Applicants respectfully request reconsideration of the pending rejections based on the following comments.

Obviousness-Type Double Patenting Rejections

A. U.S. Patent No. 7,163,929.

Claims 89 and 130-187 are rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-31 of U.S. Patent No. 7,163,929 ("the 929 patent"). Specifically, the Examiner alleges that the instant claims are not patentably distinct from the claims of the '929 patent because "it would be obvious to treat members of the the Flaviviridae virus family of viruses ith the same composition." (Office Action, page 3). Applicants respectfully disagree.

An obviousness-type double patenting rejection is appropriate only when the claims at issue are not "patentably distinct" from the claims of a commonly owned earlier patent. *See Eli Lilly & Co. v. Barr Laboratories, Inc.*, 251 F.3d 955, 967 (Fed. Cir. 2001). A claim is not patentably distinct from an earlier patent claim if the later claim is "obvious over, or anticipated by, the earlier claim." *Id.* at 968.

The instant claims recite, *inter alia*, methods of treating hepatitis C virus infections. As pointed out in Applicants' previous response, the '929 patent disclose methods of treating flavivirus or pestivirus infections, while the instant claims recite methods of treating hepatitis C virus infections. The mere fact that the viruses recited in the claims of the '929 patent belong to the same family as the virus of the instant claims does not change the fact that they are distinct viruses. Indeed, the specification of the '929 patent discloses that hepatitis C

virus belongs to its *own genus*, hepacivirus, which is distinct from the flavivirus and pestivirus genuses. (Column 12, lines 6-9). Thus, the instant claims are directed to an *entirely different invention* than the claims of the '929 patent—the treatment of hepatitis C virus infections, not flavivirus or pestivirus infections. The policy behind a double patenting rejection—the prevention of an unjustified extension of the term of a patent—does not support the Examiner's rejection in this case. *See In re Kaplan*, 789 F.2d 1574, 1579 (Fed. Cir. 1986) ("the basis for...obviousness-type double patenting rejections is timewise extension of the patent right"). Allowance of the instant claims, directed to hepatitis C virus infections, would not result in the extension of the term of the '929 patent, which covers only flavivirus and pestivirus infections. Therefore, Applicants respectfully request that the double patenting rejection be withdrawn.

B. U.S. Patent Application No. 11/005,472.

Claims 89 and 130-187 are rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 2-17 and 19-75 of U.S. Patent Application No. 11/005,472.

If provisional obviousness-type double patenting rejections are the only rejections remaining in an earlier filed pending application, the Examiner should withdraw those rejections and permit the earlier-filed application to issue as a patent without a Terminal Disclaimer. Manual of Patent Examination Procedure § 804, subsection I.B.

The filing date of the instant application is June 20, 2003. The filing date of U.S. Patent Application No. 11/005,472 is December 6, 2004. Therefore, because the instant application is the earlier-filed application, and only the provisional obviousness-type double patenting rejection remains, Applicants respectfully request that the Examiner withdraw the rejection and allow the instant application to issue as a patent without a Terminal Disclaimer.

CONCLUSION

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

Please apply fees for a Request for Continued Examination ($810.00) and any other charges, or any credits, to Jones Day Deposit Account No. 503013 (ref. no. 417451-999044).

If the Examiner believes it would be useful to advance prosecution, the Examiner is invited to telephone the undersigned at (858) 314-1200.

Respectfully submitted,

Date: October 31, 2007

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